

REMARKS

Claim 1 is amended to correct a clerical error introduced by a previous amendment; Claim 11 is amended to more clearly recite the invention. Claims 26 and 30 are amended to correct minor typographical errors. No substantive change in the scope of the claims is intended by these amendments.

Claims 1-18 and 24-36 remain pending in the application and are presented for reconsideration.

The Office Action mailed December 30, 2003, rejected claims 1-18 and 24-30 and withdrew claims 31-36 from consideration as being drawn to a separate invention. Applicant respectfully traverses the rejections of claims 1-18 and 24-30 and respectfully urges that claims 31-36 be examined, for the reasons set forth below.

**I. Claims 31-36**

The Office Action improperly withdrew claims 31-36 from consideration without satisfying the requirements for imposing a restriction requirement. The only basis given for withdrawing claims 31-36 from consideration is the assertion that they are directed to a separate invention from the original claims. Without addressing the merits of that assertion, Applicant notes that it is not sufficient to justify a restriction requirement.

Even if independent and distinct inventions are claimed in the same application, the examiner must examine all claims if the search and examination can be made without serious burden. *See* MPEP § 803. Because the Action provides no reasons why the examination of claims 31-36 would be a “serious burden” the restriction requirement is improper and should be withdrawn. Applicant therefore respectfully urges the Examiner to re-join claims 31-36 and examine them on their merits.

**II. § 112, ¶ 2 Rejection**

Claim 11 stands rejected under 35 U.S.C. § 112, ¶ 2 as indefinite because the phrase “substantially only” allegedly renders the claim unclear. Specifically, the Office Action

asserts that the phrase “substantially only” contradicts the “comprising” language in the parent claim (claim 1). Applicant respectfully traverses this ground of rejection.

Dependent claims by definition further limit their parent claims and may recite limitations that are not recited in the parent claims. In this case, parent claim 1 is open-ended as to the number of polymers in the polymer composition (a) while dependent claim 11, as presently amended, recites that “the polymer composition (a) contains substantially only the first and second acrylic-based polymers.” There is no inconsistency between the open-ended language of claim 1 and the more specific language of claim 11. Claim 11 clearly conveys to the skilled artisan the metes and bounds of the claimed embodiment, and therefore satisfies the requirements of § 112, ¶ 2. Applicant respectfully requests reconsideration and withdrawal of this rejection.

### **III. § 102(b) Rejections**

Claims 1-4, 6-12, 26, and 27 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,994, 267 by Sablotsky (“the ‘267 patent”). Applicant respectfully traverses this ground of rejection.

The present claims recite a composition comprising “a first acrylic-based polymer having substantially no functional groups and a first solubility parameter” and “a second acrylic-based polymer having a second functionality and solubility parameter, and related methods.” The ‘267 patent does not teach such compositions or methods.

Functional acrylic-based polymers are defined in the specification as polymers that have reactive chemical groups, such as carboxyl, epoxy, and hydroxy groups, which modify the acrylic-based polymers directly or provide sites for further reactions. *See* ¶ 29. Non-functional acrylic-based polymers are defined as those polymers that have no or substantially no functional reactive moieties present in the acrylic. Examples of non-functional acrylic-based polymers include acrylic esters, which can be copolymerized with other monomers but which do not have functional groups, such as vinyl acetate. *See* ¶ 30.

The ‘267 patent describes compositions comprising combinations of polymers, acrylic and non-acrylic based, and describes polymers that do and do not contain functional groups,

but there is no teaching in the '267 patent that would lead someone skilled in the art to the present invention: a composition comprising an "acrylic-based polymer having substantially no functional groups and a first solubility parameter" and "a second acrylic-based polymer having a second functionality and solubility parameter."

The Office Action cites the '267 patent for disclosing a dermal composition comprising a multipolymer containing an ethylene vinyl acetate polymer (EVA) and an acrylic polymer. *See* '267 patent, Abstract & claim 1. Applicant notes, however, that the EVA polymer of the '267 patent is not an acrylic polymer. Thus, the multipolymer of the '267 patent does not anticipate the composition of the present invention, which comprises first and second acrylic-based polymers.

The Examiner makes an apparent attempt to remedy this deficiency by relying on a passage in the '267 patent that states that acrylic monomers can be added to the EVA polymer to form a copolymer or a terpolymer. *See* Office Action at 4, citing '267 patent at col. 3, ll. 60-65. However, the addition of acrylic monomers to the EVA polymer of the '267 patent does not convert the EVA polymer into an "acrylic-based polymer," as that term is used in the art. The '267 patent itself supports this distinction. For example, the '267 patent repeatedly refers to the polymer as an "ethylene/vinyl acetate polymer" despite the optional presence of some acrylic monomers. *See, e.g.*, '267 patent at col. 2, ll. 30-32; col. 3, ll. 59-65; col. 4, ll. 41-45; claim 1. That the '267 patent does not suggest an "acrylic-based" EVA polymer is further demonstrated by the only specific teaching on point: Claim 10 recites an EVA polymer with acrylic units, but only 0-5% acrylic units are permitted.

The Office Action relies on Examples 8 and 9 of the '267 patent "to show [a] composition comprising [a] mixture of two acrylic polymers." Examples 8 and 9 do disclose a combination of two acrylic polymers, but neither example teaches or discloses that one of the acrylic polymers contains "substantially no functional groups" while the other has a second functionality, as recited in the present claims. In fact, the acrylic polymers recited in Examples 8 and 9 are both acid functional polymers. Moreover, there is no suggestion in the '267 patent to modify the composition of the examples to replace one of the functional

polymers with a non-functional polymer. Thus, these examples do not anticipate the claimed invention nor do they suggest the claimed invention.

In summary, the '267 patent does not teach or suggest a composition or method as claimed, and the § 102 rejection of claims 1-4, 6-12, 26, and 27 should be withdrawn .

#### **IV. § 103 Rejections**

Claims 5, 13-18, 24, 25, 28, and 29 stand rejected under 35 U.S.C. § 103 as obvious over U.S. Patent No. 4,994,267 ("the '267 patent") in view of U.S. Patent No. 5,474,783 ("the '783 patent"). Applicant respectfully traverses this ground of rejection.

As set forth above, the '267 patent does not disclose or suggest a polymer composition of two or more polymers which includes "a first acrylic-based polymer having substantially no functional groups and a first solubility parameter" and "a second acrylic-based polymer having a second functionality and solubility parameter," as presently claimed. There is nothing in the '783 patent that provides those teachings. Thus, the combination of the '267 patent and the '783 patent does not establish a prima facie case of obviousness. Applicant therefore respectfully urges the Examiner to reconsider and withdraw this rejection.

**V. Conclusion**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

If there are any questions regarding this submission, or if any issues remain, the Examiner is invited to contact the undersigned by telephone.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date January 31, 2005

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